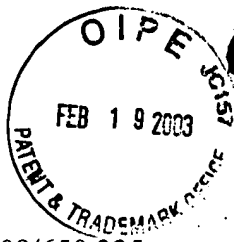


12643/210

Serial No.: 09/650,335



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND PATENT INTERFERENCES

In re U.S. application of: Jeffrey A. Giacomel

U.S. Serial No.: 09/650,335

Filed: August 28, 2000

Group Art Unit: 3743

Examiner: A. Flanigan

For: FOOD PREPARATION AND STORAGE DEVICE

RECEIVED

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TECHNOLOGY CENTER R3700

Assistant Commissioner for
Patents
Washington, D.C. 20231

Dear Sir:

REPLY BRIEF ON APPEAL

CERTIFICATE OF MAILING
(37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail and in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: February 12, 2003

William R Gustavson

(Typed name of person mailing paper)

(Signature of person mailing paper)

This reply brief is filed in furtherance of the Appeal filed in this application on May 28, 2002 and in reply to the Examiner's Answer mailed on December 12, 2002..

A. The Examiner's argument to sustain the Rejection under 35 U.S.C. Section 112, second paragraph is Respectfully Challenged

As noted, it is clear that an Applicant can define an environment for the elements.

of a claim by reciting in the preamble a structure or thing that is not an element of the claim. Claim 1 does not intend to claim the mass of product itself that the apparatus is designed to heat or cool. However, there is no error in setting forth how the claimed apparatus interacts with the mass of product to achieve the desired result. It is also a structural description of the nature of the input heat transfer elements, namely that they are suitable, and structured, to be inserted in the mass of product. Applicant believes claim 1 fully meets the requirements of Section 112.

Again, with regard to claim 4, the Applicant has the right to define the environment for the elements of the claim. Neither the mass of product nor the pan are elements of claim 4. However, the recitation of the pan as an environmental factor is important to provide precision to the nature of the at least one input heat transfer element by defining the dimensions and nature of the element such that it contacts the bottom of the pan. Thus, it also provides a structural description of the nature of the input heat transfer element, namely that it is suitable, and structured, to contact the bottom of the pan. Applicant therefore believes claim 4 also fully meets the requirements of Section 112.

B. The Examiner's argument to sustain the Rejection under 35 U.S.C. Section 102 is Respectfully Challenged

Claim 1 requires at least two input heat transfer elements in parallel spaced planes. US patent 3,229,757 to Root et al (hereinafter "Root") discloses a heat dissipation apparatus 10 for cooling a transistor unit 14. The transistor unit 14 only comes into contact with a single elongate bar 19, and clearly the Root patent cannot be a proper Section 102 reference to claim 1 as it does not disclose at least two input heat transfer elements in parallel spaced planes. The Examiner's assertion that Root has both input heat transfer fins a-d and w-z and output heat transfer fins on the opposite side of the web members 17 and 18 from fins a-d and w-z is not reasonable. The fins a-d and w-z, and the fins on the opposite side of the web members 17 and 18 are all heat dissipation fins.

As Judge Learned Hand stated, for a prior patent to be an anticipation, it "must bear within its four corners adequate directions for the practice of the patent invalidated", and if the earlier disclosure "offers no more than a starting point for further experiments...(and) if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge and it is not an anticipation." Dewey & Almy Chem. Co. V. Mimex Co., 52 U.S.P.Q. 138 (2d Cir. 1942). Here, the Examiner has based the rejection on the insight provided by the disclosure of the present application. Root never suggests or provides for heat transfer from a mass of product. It does not teach one how to transfer heat from a mass of product. To require reliance on the insight provided by the disclosure as the Examiner does here negates a reference as anticipatory. In re Arkley, 172 U.S.P.Q. 524 (C.C.P.A. 1972). It cannot be argued here that Root teaches the invention of the present claims. How can Root be used to contact a material and cool it as the Examiner argues when Root has mounting flanges 11

and 12? A reference cannot anticipate what it does not enable. University of California v. Eli Lilly and Co., 39 U.S.P.Q.2d 1225, 1242 (S.D. Ind. 1995) aff'd, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997), cert denied, 118 S.Ct. 1548 (1998). How can Root be seen to enable the present claimed invention? Root does not have input and output heat transfer elements, nor does it need to as it just dissipates heat from a transistor unit 14. Unless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation. Sandisk Corp. V. Lexar Media, Inc., 91 F. Supp.2d 1327, 131336 (S.D. Calif. 2000). Root has heat dissipation fins. Claim 1 has separate heat input and output transfer elements. The elements of Root and claim 1 are not in the same situation and do not perform the identical function.

Claim 2 requires a plurality of air contact fins. Thus, at least two separate elements are for contacting the mass of product and at least two are not. As noted, Root only has a single bar 19 in contact with transistor unit 14.

Root does not suggest the use of stainless steel, cast iron or copper as recited in claim 6. Root, at column 2, line 9-11, recites "other heat-conductive metal", not specifically stainless steel, cast iron or copper.

As claim 7 requires the input and output heat transfer elements to be formed as a unitary body, there can be no question of the impropriety of the section 102 rejection as Root does not have at least two input heat transfer elements in a unitary body. In fact, literally, Root discloses a combination of an apparatus 10 and a transistor unit 14. Root is thus not a unitary body, but a transistor unit 14 bolted to an apparatus 10. As disclosed in Root, apparatus 10 has no utility apart from transistor unit 14.

Further, claim 20 requires the input heat transfer element to be a rectangular fin. Root does not disclose a rectangular fin forming an input heat transfer element.

Claim 22 requires a plurality of product contacting input heat transfer elements for insertion within a mass of product with the elements being fins having first and second major fin surface areas that are generally parallel. Again, Root only discloses a single elongate bar 19. Thus Root does not disclose a plurality of product contacting input heat transfer elements being fins with generally parallel first and second major fin surface areas. The words "product contacting" in claim 22 are limitations to the structure of the input heat transfer elements, and are thus proper.

Claim 23 recites a plurality of product contacting input heat transfer elements. The rejection of this claims under Section 102 is improper for the same reasons set forth above with regard to claims 1 and 22. Further, claim 23 requires a plurality of both the product contacting input heat transfer elements and a plurality of output heat transfer elements, all formed of a single extruded body of aluminum, while Root is a combination of apparatus 10 and transistor

unit 14.

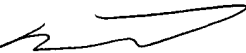
C. The Examiner's argument to sustain the Rejection under 35 U.S.C. Section 103 is Respectfully Challenged

The Examiner asserts it would be obvious to coat the surfaces of Root. However, it is well established that the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Mills, 916 F.2d 680, 682, 16 USPQ 1430, 1432 (Fed. Cir. 1990). Here, there is no incentive in Root to coat any surfaces of apparatus 10. Root achieves its desired function of cooling transistor assembly 14 best by providing no coating to the heat dissipator apparatus 10. The Examiner supports the rejection on the basis that "the use of such coatings is well known in the art". However, Applicant does not wish to patent the coatings, but instead the combination of the apparatus of claim 1 with the coating. The only reference cited by the Examiner, the Root patent, has no use for a coating. It would not be obvious to use a coating to cool a transistor, let alone provide heat transfer from a mass of material. Therefore, the obviousness rejection over Root cannot be sustained.

CONCLUSION

For the reasons set forth above, allowance of claims 1, 2, 6, 7 and 20-23 is respectfully requested.

Respectfully Submitted,
Attorneys for Applicant

By: 
William R. Gustavson
Registration No. 29,160

WRG:bg
Thompson & Gustavson, L.L.P.
February 11, 2003
Suite 1185
9330 LBJ Frwy.
Dallas, Texas 75243
(972) 479-0903